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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,867	09/12/2003	Percy Greenberg	55404/116/101	8977
5909	7590	03/09/2005	EXAMINER	
NAWROCKI, ROONEY & SIVERTSON SUITE 401, BROADWAY PLACE EAST 3433 BROADWAY STREET NORTHEAST MINNEAPOLIS, MN 554133009				SPAHN, GAY
ART UNIT		PAPER NUMBER		
3635				

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/661,867	GREENBERG, PERCY
	Examiner Gay Ann Spahn	Art Unit 3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 September 2003 and 02 February 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) 10 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02 February 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 02 February 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because there is no date of publication, place of publication, and other relevant pertinent information, as is required by 37 CFR 1.98(b)(5). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Drawings***

The drawings are objected to because: (1) Figure 1 shows reference numeral 26 which does not appear to be discussed in the specification; (2) Figure 3 shows two reference numerals above reference numeral 12 and below reference numeral 35 (on the lower left-hand side of the figure) which are not clear, but are believed to be reference numeral 38 (above and to the left of reference numeral 12) and reference numeral 30 (below and to the left of reference numeral 35) and the lead lines leading from reference numerals 38, 30, and 35 should be leading to and touching the structure that they are meant to represent; (3) the lead lines leading from reference numerals 12, 38, and 30 in Figure 4 and the lead lines from reference numerals 46, 60, and 62 in

Figure 5 should be leading to and touching the structure that they are meant to represent; and (4) Figure 15 has reference numeral 18 which is not discussed in the specification (it is believed that reference numeral 18 should be reference numeral 10 and if so, the lead line should end in an arrow to represent the entire assembly). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities: (1) on page 6, lines 6 and 13, it is believed that reference numeral 12 should be reference numeral

12'; and (2) on page 6, the last line, reference numeral 14 does not appear to be shown in the drawing figures.

Appropriate correction is required.

#### ***Claim Objections***

Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is noted that both claim 6 and claim 10 recite that "said first upstanding leg has an angled central portion." Therefore, since claim 10 is indirectly dependent upon claim 6 (i.e., claim 10 is dependent upon claim 9 which is dependent upon claim 8 which is dependent upon claim 7 which is dependent upon claim 6), claim 10 fails to further limit claim 9 because claim 9 already includes the subject matter recited in claim 10.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 lacks antecedent basis with respect to the terms "said second upstanding leg" in line 3 and "an adjacent panel" in line 5 for the following reasons. Claim 15 is directly dependent upon claim 14 (which in lines 3-4, recites "a second

upstanding leg of an adjacent panel") and indirectly dependent upon claim 12 (which in lines 2-3, recites "a panel having . . . a second upstanding leg"). Therefore, when claim 15 recites (in lines 2-3) that "said first upstanding leg is longer than said second upstanding leg," it is not understood which second upstanding leg is being referred to. Is it the second upstanding leg of the panel (12) or the second upstanding leg of the adjacent panel (12')? In addition, in line 5, claim 15 recites "an adjacent panel." It is not clear if claim 15 is reciting another adjacent panel or if it should say --said adjacent panel-- in order to refer back to the "adjacent panel" already recited in line 4 of claim 14.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Cotter '434.

Cotter '434 discloses that in a standing seam roofing assembly (2) of the type having a panel (4) with first and second upstanding legs (8, 6) along opposing side edges thereof and means for anchoring (12) said panel (4), the improvement which comprises:

a receiving lip (32) extending along said first upstanding leg (8) at a location between the panel (4) and leg terminus (end of 54) and forming an upwardly open channel, said means for anchoring (12) slidably engaging said channel.

As to claim 2, Cotter '434 discloses that his standing seam roofing assembly (2) has said receiving lip (32) being located at a lower region said first upstanding leg (8).

As to claim 3, Cotter '434 discloses that his standing seam roofing assembly (2) has said receiving lip (32) being located at an outer portion of said first upstanding leg (8).

As to claim 4, Cotter '434 discloses that his standing seam roofing assembly (2) has said means for anchoring (12) having a base portion (28) for securing said assembly (2) to a roof, and a mating portion (downward leg of U-shaped portion 30) for mating with said channel of said receiving lip (32).

As to claim 6, Cotter '434 discloses that his standing seam roofing assembly (2) has said first upstanding leg having an angled central portion (see right-angled portion between 62 and 52).

As to claim 7, Cotter '434 discloses that his standing seam roofing assembly (2) has an upper folded region (56) forming a seal that is substantially flush with a lower portion of said first upstanding leg (8).

As to claim 8, Cotter '434 discloses that his standing seam roofing assembly (2) has said receiving lip (32) being located at an outer portion of said first upstanding leg (8).

As to claim 9, Cotter '434 discloses that his standing seam roofing assembly (2) has said means for anchoring (12) including a base portion (28) for securing said assembly to a roof, and a mating portion (downward leg of U-shaped portion 32) for engaging said receiving lip (32).

As to claim 10, Cotter '434 discloses that his standing seam roofing assembly (2) has said first upstanding leg (8) having an angled central portion (see right-angled portion between 62 and 52).

As to claim 12, Cotter '434 discloses a standing seam roofing assembly (2) comprising:

a panel (4) having a first upstanding leg (8) at a first longitudinal edge and a second upstanding leg (6) at a second longitudinal edge, said first upstanding leg (8) having a receiving lip (32) on an outer portion thereof; and

an anchor (12) having a mating portion (downward leg of U-shaped portion 32) slidably received over said receiving lip (32), and a base portion (28) for securing said anchor (12) to a roofing surface.

As to claim 13, Cotter '434 discloses that his standing seam roofing assembly (2) has said anchor mating portion (downward leg of U-shaped portion 32) defining a channel engaging said first upstanding leg (8) over said receiving lip (32).

As to claim 14, Cotter '434 discloses that his standing seam roofing assembly (2) has said first upstanding leg (8) of said panel (4) being received within a second upstanding leg (6) of an adjacent panel (4).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotter '434 in view of Knudson '404.

Cotter '434 discloses the standing seam roofing assembly (2) as discussed above. Cotter '434 fails to disclose that the standing seam roofing assembly (2) has a first upstanding leg (8) that is longer than the second upstanding leg (6). Knudson '404 discloses a standing seam roofing assembly (see Figure 4) having seam-connected panels (11, 12), wherein the panel (12) on the side of the anchor (41) is shorter than the other panel (11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the first upstanding leg (8) of Cotter '434 to be longer than the second upstanding leg (6) as taught by Knudson '404 in order to provide for the roof panels to be more tight-fitting against the surface of the roof so as to prevent air-spaces and gaps which could be places susceptible to moisture condensation and where not necessary for provision of the anchoring bracket and fastener.

#### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Claims 1-4, 6, 8, 9, 12, and 13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 6, 8, 9, 12, and 13 of copending Application No. 10/775,400. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5, 10, 11, 14, and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 10, 11, 14, and 15 of copending Application No. 10/755,400. Although the conflicting claims are not identical, they are not patentably distinct from each other because in view of the teachings of USSN 10/755,400: (1) with respect to claims 5, 11, 14, and 15, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the first upstanding leg of USSN 10/661,867 longer than its second upstanding leg so as to assure that the first upstanding leg will envelop the second upstanding leg upon attachment while at the same time allowing for space between the panel and the anchoring means; and (2) with respect to claim 10, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to make the first upstanding leg of USSN 10/661,867 have an angled central portion in order for the receiving lip on the outer portion of the first upstanding leg to have space within which to be connected to the mating portion of the anchor and still be co-extensive or flush with the folded region of the two panels above the angled portion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 4,694,628 to Vondergoltz et al. discloses a metal building panel with standing seam edge formations. U.S. Patent No. 4,870,798 to Richter discloses a double lock standing seam roof sheet. U.S. Patent No. 5,001,881 to Boyd discloses a sheet cladded roof assembly and cleat arrangement. U.S. Patent No. 5,134,825 to Berridge discloses an apparatus for moisture resistant seam assembly. U.S. Patent No. 5,140,793 to Knudson discloses a snap-on positive snap-lock panel assembly. U.S. Patent No. 5,187,911 to Cotter discloses a standing seam roofing/cladding system. U.S. Patent No. 5,247,772 to Greenberg discloses a standing seam roofing panel having opposed elevated ridges to define first and second dikes. U.S. Patent No. 5,519,974 to Greenberg discloses a standing seam roofing panel including first and second dikes integral with opposite longitudinal edges of a panel. U.S. Patent No. 5,535,567 to Cahoon discloses a standing seam roofing panel having large and small dikes extending along its longitudinal edges. U.S. Patent No. 5,584,153

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to Nunley et al. discloses a composite roof system with an improved anchoring mechanism.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (703)-605-1203. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703)-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gay Ann Spahn, Patent Examiner  
March 3, 2005



Carl D. Friedman  
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Group 3600